

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Ryota SUGIMOTO

Application No.: **09/870,672**

Filing Date: June 1, 2001

For: IMPLANTABLE TUBULAR DEVICE

Art Unit: 3764

Examiner: Mathew, Fenn C.

Attorney Ref. No.: MA3005-0031

Confirmation No.: 8651

REPLY BRIEF FOR APPELLANT

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed on March 23, 2007, Appellant presents this Reply Brief in support of the appeal of the final rejections of Claims 1, 4, 5, 9-20, 22, 23, and 32-45 in the above-captioned patent application. This Reply Brief is due to be filed on May 23, 2007.

It is not believed that any further extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application or dismissal of this appeal, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to the Applicant's Representative's credit account authorized in Appellant's representative's June 25, 2005 response papers or to Applicant's Representative's Deposit Account No. 50-2821.

I. ARGUMENT

New Interpretation of Palmaz'977 Fails to Make Up for Deficiencies in the Rejections of Claims under 35 U.S.C. §103

In the Examiner's Answer, the Examiner acknowledges that reliance on the "serpentine" grooves 400'' in the Palmaz'977 reference fails to provide adequate basis for rejecting the Appellant's pending claims. Nonetheless, the Examiner constructs a new interpretation and argument in the Examiner's Answer to allegedly provide support for the outstanding rejections under 35 U.S.C. 103. It is respectfully submitted that no interpretation of the Palmaz'977 reference provides the necessary evidence to uphold a *prime facie* case of obviousness against Appellant's pending claims.

The Examiner's new position stated in the Examiner's Answer is that "groove 400'''' shows a single groove extending across a portion of a stent...perpendicular to [an] axial lengthwise direction of the stent" and that this particular groove, if provided in a symmetrical pattern of grooves, would "clearly...result in an endless annular configuration." Appellant respectfully disagrees with this jump in logic, and submits that this statement is conclusory and unsupported by any teaching or other evidence in the applied art.

In particular, there is no teaching in the Palmaz'977 reference (or other applied reference) that supports the Examiner's conclusion that a symmetrical pattern of the disclosed grooves 400'''' would result in either a groove with "an endless annular configuration" as recited in Appellant's claims 1 and 33 or in a groove with a "spiral configuration" as recited in claim 32. By contrast, grooves 400'''' of Palmaz'977 can be combined in countless iterations and combinations such that they are symmetrical and also do not "read upon" or teach Appellant's claimed invention. The teaching that grooves 400'''' can be combined in a symmetrical pattern of grooves simply does not provide the requisite evidence to support an obviousness type rejection of Appellant's claimed invention. One of skill in the art would have had no reason to arrange the grooves 400''''

in the particular manner suggested by the Examiner, except for the purpose of rejecting Appellant's claims. Moreover, there is absolutely no teaching in the Palmaz'977 reference that endothelial cell growth can be aided by using grooves having the features of "an endless annular configuration" or a "spiral configuration" as set forth in Appellant's claims.

The same arguments apply to the Examiner's newly stated position that, if continuously extended, diagonal grooves 400' "would lead to a spiral configuration." There is no disclosure or teaching in either Palmaz'977 or any other art of record that provides the evidence necessary to conclude that the grooves 400' could be reconfigured or extended to form a "spiral configuration" as recited in Appellant's claim 32. Again, there are many other symmetrical and asymmetrical configurations for the groove 400' that would not "read upon" Appellant's claims.

The only reason the Examiner chooses to modify the grooves 400' and 400' of Palmaz'977 (without the use of another reference as a teaching) is to meet Appellant's claims through the use of Appellant's claims as a roadmap. This is the exact definition of the use of impermissible hindsight. Palmaz'977 and the other art of record simply fail to teach or disclose, either alone or in combination, at least the feature of a groove with "an endless annular configuration" or "spiral configuration" as recited in Appellant's claims. In addition, none of the references, either alone or in combination disclose or teach grooves "formed on the bent portions of the wavy annular members" as recited in claims 1 and 33, or "located on each of the plurality of bent portions" as recited in claim 32, as argued in more detail in Appellant's Appeal Brief filed in this case on April 3, 2006.

Recent Case Law Changes Regarding 35 U.S.C. §103

The U.S. Supreme Court has recently addressed the obviousness of a combination of known elements. Although a rigid application of the Court of Appeals for the Federal Circuit's "teaching, suggestion, or motivation" test was rejected, the Court stated that "a combination of

familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR International Co. v. Teleflex Inc. et al.*, No. 04-1350, slip op. at 12 (S.Ct., April 30, 2007). For example, the Court explained, when the prior art elements work together in an unexpected and fruitful manner, a finding of non-obviousness is supported. *Id.* (citing *United States v. Adams*, 383 U.S. 39, 40 (1966)). If, however, a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.” *Id.* (citing *Sakraid v. AG Pro, Inc.*, 425 U.S. 273 (1976)).

The Court in *KSR* still required that there be a reason or purpose for modifying the prior art to arrive at the claimed invention, and in order to find the claimed subject matter unpatentable under section 103(a). *Id.* at 14-15 (“Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”).

It is respectfully submitted that the recent case law summarized above does not change Appellant’s conclusion that the combination of the Shanley’967 reference with the Palmaz’977 reference (or the Alt’979 reference) is in error, and would not have obviated Appellant’s pending claims. Specifically, as indicated above and in Appellant’s Brief filed on December 5, 2006, there are specific claim elements that are completely absent from any of the applied art references, and therefore even if combined, the resulting structure would not obviate the claimed invention. In addition, the “established functions” of the applied art references would not have lead one of ordinary skill in the art to combine the applied art in a way, and backed by an appropriate “reason” instead of by chance, that would arrive at the specifically claimed invention.

II. Conclusion

For at least the foregoing reasons, Appellant respectfully submits that the subject matters of Claims 1, 4, 5, 9-20, 22, 23, and 32-45, each taken as a whole, are patentable. Accordingly, Appellant respectfully requests reversal of the rejections of Claims 1, 4, 5, 9-20, 22, 23, and 32-45 under section 103(a).

Respectfully submitted,

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